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Serial No.: 10/049,219
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REMARKS

The Office Action mailed March 23, 2004, has been carefully considered together with each of the references cited therein. The amendments and remarks presented herein are believed to be fully responsive to the Office Action. The amendments made herein are fully supported by the Application as originally filed. No new matter has been added. Accordingly, reconsideration of the present Application in view of the above amendments and following remarks is respectfully requested.

CLAIM STATUS

The claims pending in this Application are 18-34. By this Amendment, Applicants have amended 18-26 and 29. Claims 27, 28 and 30-36 have been canceled, while new claims 37, 38 and 39 have been added. Consequently, the claims under consideration are believed to include claims 18-26, 29 and 37-39.

Claim Rejections Under 35 USC § 102(b) or in the Alternative, Under 35 USC § 103(a)

Claims 18-21 stand rejected under 35 USC § 102(b) as anticipated by or, in the alternative, under 35 USC § 103(a) as being unpatentable over Joyner et al. (US 4,483,969) for the reasons cited in previous Office Actions. This rejection is respectfully overcome.

Applicants' invention, as defined by the amended claims, is directed to a method for treatment of a textile piece good that includes adding to a polyester to an aqueous liquor. The polyester is end capped with monofunctional adducts of ethylene oxide onto a C₁₋₄ alkanol.

Joyner et al. disclose emulsifiable polyester waxes which are end capped with polyfunctional organic anhydrides. See, *inter alia*, abstract; column 1, lines 65-67 and claim 1.

A rejection under § 102 requires the prior art reference to disclose each and every element of a claimed invention, and, as Joyner et al. does not disclose

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monofunctional end capped polyesters, it is respectfully contended that Applicants' invention is not anticipated thereby.

With respect to § 103, a *prima facie* case of obviousness requires the prior art to provide some motivation for one with ordinary skill in the art to arrive at the claimed invention. Here, Joyner fails to provide the required motivation, as there is nothing within Joyner that would motivate one with ordinary skill in the art to substitute the polyfunctional end caps with Applicants' claimed monofunctional adducts. As the prior art does not contain the motivation necessary to establish a *prima facie* case, Applicants contend, respectfully, that the Office is engaging in impermissible hindsight gained by a knowledge of Applicants' disclosure. Applicants, therefore, assert that Joyner does not make claims 18-21 obvious under 35 USC § 103.

Claims 18-34 stand rejected under 35 USC § 102(b) as anticipated by or, in the alternative, under 35 USC § 103(a) as being unpatentable over Miracle et al. (US 5,576,282). This rejection respectfully overcome.

Independent claim 18 is directed to a method of treating a textile piece good wherein the method is used during pretreatment, dyeing, optical brightening or after treatment of the textile piece good. The claimed polyester is added to the aqueous bath in order to prevent the formation of transport folds or the occurrence of friction in or on the textile substrate during pre-treatment, dyeing, optical brightening or after-treatment, i.e. during formation of the textile itself.

In contrast, Miracle is directed to a bleach booster and detergent composition employed in the laundering of made, formed garments. Miracle does not disclose or teach a method for treating a textile piece good wherein the claimed polyester is added to the aqueous bath in order to prevent transportation folds or friction in or on the substrate during the processing of the textile. In consequence, Applicants' invention, as defined by independent claim 18 and all claims depending therefrom, are not anticipated by Miracle et al.

Similarly, under § 103, Miracle does not disclose, teach, suggest, or intimate that the claimed polyester is capable of preventing transportation folds

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or the occurrence of friction in a substrate during its processing. The absence of this teaching is readily apparent when it is recognized that Miracle discloses a composition used for laundering garments rather than decreasing the occurrence of deleterious effects during production of a textile. As the laundering of garments is a totally different technology and different field of application, one with ordinary skill in art having a knowledge of Miracle would not find any motivation to place the claimed polyester in an aqueous bath during the pre-treatment, dyeing, optical brightening or after treatment of a textile piece good. Thus, Applicants contend that independent claim 18, and all claims depending therefrom, are not made obvious by Miracle et al.

Concerning independent claim 29, Applicants claim an aqueous wet-acting lubricant composition consisting essentially of the claimed polyester and a thickening agent selected from the group consisting of xanthan gum, homopolyacrylamides, copolyacrylamide-acrylic acid and partially saponified polyacrylamides. Miracle does not disclose, teach, or suggest this composition as it does not disclose this combination of constituents, and therefore, claim 29, and all claims depending therefrom, are not anticipated by, or made obvious by Miracle et al.

In view of the foregoing, Applicants respectfully seek reconsideration and withdrawal of the § 102 and 103 rejections.

Claim Objection

Claim 18-34 stand objected to because of variables contained within parentheses. The Office states that the use of variables is "unnecessary and make the claims difficult to comprehend and makes many claims incomprehensible." The subject claims have been amended, replacing the parenthetical variables with "definite words" to define the boundaries of the subject matter for which patent protection is sought, in accordance with the Office's suggestion.

In view of the foregoing, it is respectfully contended that the claim objection has been overcome.

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Claim Rejections Under 35 USC § 112

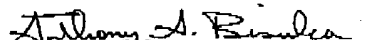
Claims 27-29, 32 and 33 stand rejected under 35 USC § 112, second paragraph as being indefinite. Claims 27, 28, 32 and 33 have been canceled. Claim 29 has been amended to recite an aqueous wet-acting lubricant consisting essentially of water dispersible or colloiddally soluble, end-capped and a thickening agent, wherein the polyester is produced by the esterification or transesterification of certain compounds.

In view of the foregoing, Applicants believe that the 35 USC § 112, second paragraph rejection has been overcome.

As the total number of claims does not exceed the number of claims originally paid for, no fee is believed due. However, if an additional fee is required, the Commissioner is hereby authorized to credit any overpayment or charge any fee deficiency to Deposit Account No. 03-2060.

In view of the forgoing amendments and remarks, the present application is believed to be in condition for allowance, and reconsideration of it is requested. If the Examiner disagrees, she is requested to contact the attorney for Applicants at the telephone number provided below.

Respectfully submitted,


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